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EXAMINER

ROSSI, JESSICA

| ART UNIT | PAPER NUMBER |
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1733

DATE MAILED: 01/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/877,372

Applicant(s)

SCHOLZ, KONRAD

Examiner

Jessica L. Rossi

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10/18/04, Amendment.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
4a) Of the above claim(s) 1-4 and 13 is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 5-12 and 14-18 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

1. This action is in response to the amendment dated 10/18/04. Claims 16-18 were added. Claims 1-18 are pending but claim 1-4 and 13 remain withdrawn from further consideration (see paragraphs 5-6 below).
2. Support for “a surface of a profile bar” in line 2 of claim 5 can be found on p. 9, lines 14-15. Support for “a surface profile” in line 3 of claim 5 can be found on p. 6, lines 7-9 and p. 9, lines 11-17. Support for the pressure face deformably matching exerting uniform pressure “independent of the shape of the profile” in line 7 of claim 5 can be found on p. 6, lines 10-13. Support for the elastic band being spring-steel can be found on p. 6, lines 25-27. Support for the workpiece having a “cross sectional surface” in line 2 of claim 16 can be found on p. 9, lines 11-17.
3. The rejection of claims 5-8, 10-12, and 14-15 under 35 U.S.C. 112 2nd paragraph, as set forth in paragraph 9 of the previous office action, has been withdrawn in light of the present amendment to the claims.
4. The rejection of claims 5-6 and 8 under 35 U.S.C. 102(b) as being anticipated by Duewel (of record), as set forth in paragraph 11 of the previous office action, has been withdrawn in light of the limitation added to claim 5 which states that the pressure face deformably matches and exerts uniform pressure “independent of the shape of the profile.” Note spindle 18 of Duewel would not deformably match and exert uniform pressure on an edge that is not flat and therefore fails to teach or suggest the spindle deformably matching and exerting uniform pressure independent of the shape of the profile.

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Election/Restrictions

5. Newly submitted claims 17-18 are directed Species that are independent or distinct from the Species originally claimed for the following reasons:

Applicant is directed to paragraphs 1-3 of the previous office action where a Species restriction was set forth and Applicant orally elected those Species pertaining to a bandlike covering and a board element. The film and profile bar claimed in new claims 17-18 are directed to those non-elected Species pertaining to a film and a profile bar.

Since applicant has received an action on the merits for the originally presented Species, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, the film and profile bar of claims 17-18 are withdrawn from consideration as being directed to a non-elected Species. See 37 CFR 1.142(b) and MPEP § 821.03.

6. Applicant's election with traverse of Species Aixa (bandlike covering, board element) in the reply filed on 10/18/04 is acknowledged. The traversal is on the ground(s) that the full range of embodiments would not impose any additional burden on the examiner and that it is clear the examiner previously searched all embodiments.

This is not found persuasive because the claims examined in the first non-final action and subsequent final action set forth all embodiments using alternative language ("bandlike covering or film" and "board element or profile bar"; see original claim 5 and amended claim 5 filed on 6/30/03) while claims 10, 13, and 14, which were added in an RCE filed on 4/1/04, are each directed to only one of the embodiments (claim 10 directed to bandlike covering and board element, claim 13 directed to film, claim 14 directed to bandlike covering); therefore, prior to the RCE the examiner was not required to search all the embodiments to reject the claimed invention

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whereas claims 10, 13 and 14 would have forced the examiner to do just that. Also note that a restriction requirement can be imposed at any point during prosecution before final action at the discretion of the examiner (MPEP 811).

Applicant also argues that the required species election between the narrow face having a straight cross-section (species Aix) or a profiled cross-section (species Aiy) is improper. However, this argument is moot since Applicant deleted this limitation from claim 5 in the present amendment thereby eliminating the need for this particular species restriction.

Applicant also argues that the elastic band (species Aixa) and spring-steel band (species Aixb) are not mutually exclusive and therefore amended claim 9 to make it depend from claim 8. Support for such a limitation exists on p. 6, lines 25-27 and therefore the examiner has withdrawn this particular species restriction.

Applicant also argues that a board element and profile bar are not mutually exclusive species because both have a cross sectional surface. The examiner agrees that both the board element and profile bar have a cross-sectional surface; however, one reading Applicant's specification as a whole would have readily appreciated that a board element is not a profile bar and vice versa and therefore would have treated them as mutually exclusive species.

The requirement is still deemed proper and is therefore made FINAL.

Claim Objections

7. Claims 5, 12 and 15 are objected to because of the following informalities:

Claim 5, line 10: --of the board element or the surface of the profile bar-- should be inserted after "face" in line 10.

Claim 12, line 2: --- should be inserted after "face".

Claim 15, line 2: --or surface-- should be inserted after "face".

Appropriate correction is required.

Claim Rejections - 35 USC § 112

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 5-12 and 16-18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With respect to claim 5, it recites the limitation "the shape of the profile" in line 7. There is insufficient antecedent basis for this limitation in the claim. It is suggested to change "the shape" to --a shape--.

Regarding claim 12, it is unclear how the length of the pressure element being "substantially shorter" than that of the narrow face further limits claim 10. Claim 10 states that the length of the pressure element is "less than that of the narrow face," and claim 12 depends from this claim, it appears that Applicant intends for "less than" and "substantially shorter than" to mean different things. However, it is unclear as to what this difference is since the present specification does not define what "substantially shorter than" means. Therefore, the skilled artisan cannot interpret the claim language in light of the specification and therefore cannot determine the metes and bounds of claim 12. Applicant is asked to clarify. It is suggested to do one of two things: 1) delete "less than" and insert "substantially shorter than" in claim 10 and cancel claim 12 or 2) cancel claim 12.

With respect to claim 16, it recites the limitation "the profile of said cross sectional surface" in line 6. There is insufficient antecedent basis for this limitation in the claim. It is suggested to change "the profile" to --a profile--.

Claim Rejections - 35 USC § 102

10. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

11. Claims 10-12 and 14-15 stand rejected under 35 U.S.C. 102(b) as being anticipated by Duewel (US 4222812; of record), as set forth in paragraph 11 of the previous office action.

With respect to claim 10, Duewel is directed to a method for uniformly adhering a bandlike covering 14 onto the flat edge (= narrow face) of a board element 20 (Figure 1; column 1, lines 6-15; column 3, lines 35-40). The reference teaches providing a spindle 18 that has an outer sleeve 86 of **resilient** material that comes into contact with the covering and serves as a pressure member for urging the covering against the edge and uniformly adhering the covering onto the edge using hot melt glue (column 6, lines 23-27). The skilled artisan would have readily appreciated that the resilient material of the sleeve would inherently be elastically deformable. Furthermore, the reference teaches applying the covering to only a flat edge, wherein the skilled artisan would have readily appreciated the spindle deformably matching and exerting uniform pressure on the flat edge. The reference also teaches the spindle 18 having a length that is less than that of the narrow face, as clearly shown in Figure 2.

Regarding claim 11, the reference teaches moving the board element along its length in relation to the pressure element while the covering is pressed onto the edge (column 6, lines 29-31 and 23-26).

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Regarding claim 12, the reference teaches the spindle 18 having a length that is substantially shorter than that of the edge as shown in Figure 1.

With respect to claim 14, all the limitations were addressed above with respect to claims 10-11.

Regarding claim 15, all the limitations were addressed above with respect to claims 10-12.

12. Claim 16 is rejected under 35 U.S.C. 102(b) as being anticipated by LaMers (US 4547252).

With respect to claim 16, LaMers is directed to a method for gluing a label (= covering) 14 onto a workpiece 272 with an adhesive, wherein the workpiece has a cross sectional surface (Figure 27; column 2, lines 48-57; column 10, lines 10-11). The reference teaches the covering being pressed onto the workpiece by means of a pressure element (bellows) 270 having an elastically deformable pressure face that deformably matches and exerts uniform pressure on the cross sectional surface independent of the profile of the cross sectional surface (Figure 27; column 4, line 63 – column 5, line 4; column 3, lines 55-63; column 10, lines 10-11). The reference teaches moving the workpiece along its length, in relation to the pressure element, while the covering is uniformly pressed onto the cross sectional surface (last sentence of abstract; column 3, lines 60-63).

13. Claim 14 is rejected under 35 U.S.C. 102(b) as being anticipated by Mathis.

Note claim 5 encompasses all the limitations set forth in claim 14 and therefore Applicant is directed to paragraph 19 below for a complete discussion of Mathis, which the examiner found upon further searching that was necessitated by Applicant's newly claimed limitation pertaining

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to the pressure face deformably matching and exerting uniform pressure independent of the shape of the profile.

Claim Rejections - 35 USC § 103

14. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

15. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over LaMers as applied to claim 16 above and further in view of Hodgson (US 4132583).

Regarding claim 17, LaMers is silent as to the label being bandlike. However, the reference teaches the apparatus permitting the use of a wide variety of labels including very thin and flexible labels (column 10, lines 26-27). The skilled artisan reading LaMers as a whole would have appreciated that the reference is not concerned with the shape of the label nor the shape of the workpiece and therefore would have been motivated to use a label that is bandlike because it is known in the art to apply bandlike labels L to articles having a variety of shapes, including flat and rounded, using a bellows 52 which deformably matches and exerts uniform pressure on the surface of the article independent of its shape, as taught by Hodgson (Figures 3 and 5; column 1, lines 66-68; column 2, lines 61-66; column 3, lines 67-68; column 4, lines 53-60; column 5, lines 31-50; column 9, lines 23-25; column 10, lines 3-7).

16. Claims 18, 5, 8-12, and 14-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over LaMers and Hodgson as applied to claim 17 above and further in view of Treat (US 4726865).

Regarding claim 18, LaMers is silent as to what the workpiece is and therefore is silent as to it being a board element. Hodgson teaches the workpiece can be flat, including those having a

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square or rectangular cross section (column 1, lines 66-68; column 10, lines 3-7), wherein the skilled artisan would have appreciated a flat workpiece having a square or rectangular cross section reading on Applicant's board element. Furthermore, it is known in the art to apply labels to circuit board components, as taught by Treat (column 1, lines 55-60), wherein the skilled artisan would have appreciated such board components reading on Applicant's board element.

Since LaMers is not concerned with a particular workpiece it would have been obvious to the skilled artisan to apply the label of LaMers to a board element because such is known in the labeling art, as taught by the collective teachings of Hodgson and Treat, where only the expected results would have been achieved.

With respect to claim 5, all the limitations were addressed above with respect to claims 16-18.

Regarding claim 8, LaMers teaches the bellows being an elastic band (Figure 27; column 4, lines 63-66).

Regarding claim 9, selection of a particular material for the elastic band would have been within purview of the skilled artisan.

With respect to claim 10, all the limitations were addressed above with respect to claims 16-18, except the pressure element having a length that is less than that of the narrow face of the board element. LaMers is not limited to a particular shaped workpiece and therefore is not limited to a particular size for the workpiece. Therefore, the skilled artisan would have appreciated it being obvious to apply the label of LaMers to a workpiece whose size is such that the length of the pressure element is less than that of a narrow face of the workpiece because it is well known and conventional for a label to only cover a portion of a surface.

Regarding claim 11, all the limitations were addressed above with respect to claims 10 and 16-18.

Regarding claim 12, LaMers is not limited to a particular shaped workpiece and therefore is not limited to a particular size for the workpiece. Therefore, the skilled artisan would have appreciated it being obvious to apply the label of LaMers to a workpiece whose size is such that the length of the pressure element is substantially shorter than that of a narrow face of the workpiece because it is well known and conventional for a label to only cover a portion of a surface.

With respect to claim 14, all the limitations were addressed above with respect to claims 16-18.

Regarding claim 15, LaMers is not limited to a particular shaped workpiece and therefore is not limited to a particular size for the workpiece. Therefore, the skilled artisan would have appreciated it being obvious to apply the label of LaMers to a workpiece whose size is such that the length of the pressure element is substantially shorter than that of a narrow face of the workpiece because it is well known and conventional for a label to only cover a portion of a surface.

17. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over LaMers, Hodgson and Treat as applied to claim 5 above, and further in view of Schut et al. (US 6376058; of record).

Regarding claim 6, one reading the reference as a whole would have appreciated that LaMers is not concerned with a particular adhesive. It is known in the art to attach labels to objects using a hot-melt adhesive as an alternative to a pressure sensitive adhesive, as taught by

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Schut (column 14, lines 9-15). It would have been obvious to one of ordinary skill in the art at the time the invention was made to use a hot-melt adhesive as an alternative to a pressure-sensitive adhesive for the labels of LaMers because such is known in the art, as taught by Schut, wherein only the expected results would have been achieved.

18. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over LaMers, Hodgson and Treat as applied to claim 5 above, and further in view of Paulk et al. (US 6529799; of record).

Regarding claim 7, the references are silent as to the board element comprising Applicant's claimed materials. It is known in the art to attach adhesive labels to boards wherein the board comprises such materials as chipboard, fiber board, or solid wood board, as taught by Paulk (column 4, lines 1-5; column 6, lines 1-5; column 7, lines 57-63).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to apply the label of LaMers to a board element comprising the materials claimed in the present invention because such is known in the art, as taught by Paulk, and this allows for identification of the board element based on the information printed on the label.

19. Claims 5-12 and 15-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mathis (US 4658721).

With respect to claim 5, Mathis is directed to a method for gluing an embossing foil (= bandlike covering) 5 onto a narrow face of a board element (wood, cardboard; column 1, lines 19-21; column 7, lines 5-8) with an adhesive (Figures 1-4; column 1, lines 19-41). The reference teaches the narrow face having a surface profile that can be flat (Figures 3-4), round (Figures 1-2), convex, concave, oval, etc. (column 1, lines 15-18; column 4, lines 4-8). The reference

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teaches the foil being pressed onto the narrow face by means of an embossing die 8 (= pressure element) having an elastically deformable face that deformably matches and exerts uniform pressure independent of the shape of the profile of the narrow face (Figures 1-4; column 4, lines 2-4; column 6, lines 11-28; column 7, lines 44-47; column 8, lines 3-5 and 35-41).

The reference teaches the board element and embossing die being relatively moved up to each other (column 3, lines 59-61) but is silent as to moving the board element along its length, in relation to the embossing die, while the foil is pressed onto the narrow face. It is noted that in the embodiments depicted in Figures 1-4 show the embossing die being moved with respect to the workpiece during the pressing step.

The skilled artisan reading Mathis as a whole would have appreciated that the reference is concerned with using an embossing die that conforms to the shape of the workpiece to which it applies the embossing foil and is not concerned with the element (board element or embossing die) that is moved during the pressing step. Therefore, moving the board element along its length with respect to the embossing die during the pressing step as an alternative to moving the die would have been obvious to the skilled artisan because only the expected results would have been achieved.

Regarding claim 6, Mathis teaches a hot melt adhesive (column 7, lines 54-56; column 8, lines 10-12).

Regarding claim 7, Mathis teaches the board element comprising wood (column 1, lines 19-20). Selection of a particular wood material would have been within purview of the skilled artisan at the time the invention was made.

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Regarding claim 8, Mathis teaches the deformable face of the embossing die being an elastic band (column 6, lines 10-22).

Regarding claim 9, Mathis teaches the elastic band being a spring-steel band (column 6, lines 15-17).

With respect to claim 10, all the limitations were addressed above with respect to claim 5, except the length of the embossing die being less than that of the narrow face. Mathis is not limited to a particular shaped workpiece, or a particular size for the workpiece, or the embossing foil covering the entire narrow face of the board element. Therefore, the skilled artisan would have readily appreciated it being obvious to apply an embossing foil onto a board element being of a size such that the embossing die has a length that is less than that of the narrow face of the board element because it is well known and conventional to apply printed embossing foils, such as labels, that do not cover the entire surface to which they are applied.

Regarding claim 11, all the limitations were addressed above with respect to claims 5 and 10.

Regarding claim 12, for the same reasons as set forth above with respect to claim 10, it would have been obvious to apply the embossing foil to a board element of a size such that the length of the embossing die is substantially shorter than that of the narrow face.

Regarding claim 15, all the limitations were addressed above with respect to claims 14 and 12.

With respect to claims 16-18, all the limitations were addressed above with respect to claim 5.

Response to Arguments

20. Applicant's arguments filed 10/18/04 have been fully considered but they are not persuasive.

21. On pages 9 and 10, Applicant argues with respect to claims 5 and 16 that Duewel fails to teach or suggest the pressure element deformably matching and exerting uniform pressure independent of the shape of the profile of the workpiece.

The examiner points out that Duewel is no longer being used to reject claim 5 nor has the reference been used to reject claim 16. Applicant is directed to paragraph 4 above.

22. On page 9 of the arguments, Applicant argues that Duewel fails to teach or suggest the spindle exerting uniform pressure and that the spindle of Duewel cannot be said to inherently provide uniform pressure because of its the ability to float.

The examiner in paragraph 11 above did not set forth inherency with respect to the spindle exerting uniform pressure. However, the examiner did establish that Duewel teaches applying the covering to only a flat edge and since the surface profile of the flat edge has no variations (i.e. curvature), the spindle will apply uniform pressure thereto despite its ability to float.

Conclusion

23. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO**


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MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Jessica L. Rossi** whose telephone number is **571-272-1223**. The examiner can normally be reached on M-F (8:00-5:30) First Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Blaine R. Copenheaver can be reached on 571-272-1156. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Jessica L. Rossi
Art Unit 1733